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09512734

APPLICATION NO. 09/512734	FILING DATE 10/24/00	FIRST NAMED INVENTOR LASHER	ATTORNEY DOCKET NO. C 112764.1101
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EXAMINER

SIPUS, J

ART UNIT

3721

PAPER NUMBER

14

DATE MAILED: 10/24/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No.	Applicant(s)
	09/512,734	LASHER ET AL.
	Examiner	Art Unit
	John Sipos	3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on ____ .
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) Claim(s) 1-15,20 and 23-27 is/are allowed.
- 6) Claim(s) 16-19,21,22 and 28-55 is/are rejected.
- 7) Claim(s) ____ is/are objected to.
- 8) Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on ____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on ____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. ____ .
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ . |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>6,8</u> . | 6) <input type="checkbox"/> Other: _____ |

DRAWINGS

The drawings of February 24, 2000 have been objected to by the Draftsperson for the reasons indicated in the attached PTO Form 948. The PTO no longer transfers drawings from the patent file. New drawings are required.

INFORMATION DISCLOSURE STATEMENT

The Information Disclosure Statement (IDS) of 10/10/2000 has been reviewed and an initialed copy of Form 1449 is attached. A copy of the crossed-out reference has not been received.

The IDS of 6/26/2000 seems to be for the wrong application since the applicant's name is incorrect and the subject matter of the submitted reference is not related to the subject matter of the instant application. Also, a copy of the reference has not been received. Therefore the reference has not been considered (see attached PTO Form 1449).

DECLARATION

The reissue oath/declaration filed with this application is defective because it fails to identify at least one error, which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414. The declaration does not sufficiently specify the error or give a proper example of the error. The examples set forth in the oath are the "omission of broader claims to an operator assisted prescription dispensing system and a method of dispensing pills in a prescription dispensing system". Neither of

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these is considered as an error in that the claims of the patent inherently apply to an "operator assisted" system and the "method" of operation is set forth in claims 23-27 of the patent.

Claims 28-55 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration are set forth in the discussion above in this Office action.

RECAPTURE OF SURRENDERED SUBJECT MATTER

Claims 28-55 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Original, unamended claim 15 of the parent patent is substantial equivalent of instant claim 28 while the rest of the presently submitted claims are obvious language variations of claims 15 and 28. Original claim 15 is considered to be the broadened aspect, which was surrendered in the patent. Claim 15 was allowed after the amendment of May 21, 1997, which incorporated previously allowed dependent claim 18 into claim 15 to make claim 15 allowable.

REJECTIONS OF CLAIMS BASED ON PRIOR ART

The following is a quotation of the appropriate paragraphs of 35 U.S.C. ' 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 16 and 46 are rejected under 35 U.S.C. ' 102(b) as being clearly anticipated by the patent to of Charhut (5,208,762). The patent to Charhut discloses a pill dispensing and packaging machine that comprises of a dispenser 26 having a plurality of pill dispensers containing different pills, computer control means 70 to store prescriptions, to simultaneously control each of the dispensers, to count out and dispense the pills into a package and to stop the dispensers when the desired number

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of pills are dispensed (column 3, lines 44-62, column 5, line 66 et seq.) and a labeling device 28 labels containers either during or immediately after the pills have been dispensed into the containers (see column 4, lines 1-4) thereby not producing a label for the next prescription until the previous prescription has been dispensed into its container.

Claims 21 and 52 are rejected under 35 U.S.C. ' 102(b) as being clearly anticipated by the patent to Rowlett (4,953,745). The patent to Rowlett shows a pill dispensing device which comprises of a plurality of pill dispensers containing different pills (34), computer control means (32) to store prescriptions, to simultaneously control each of the dispensers to count out and dispense the pills into a package (12 and Figure 2) and to stop the dispensers when the desired number of pills are dispensed, indicator 25 that indicates when the number of pills in a dispenser fall below a predetermined minimum (column 4, lines 34-39). The claimed "means to increase" the number of pills when pills are added to the dispenser is read on the portion of the computer that also tracks the number of pills remaining in each dispenser and as such reflects the numeric change whenever pills are removed or added to the dispenser (column 10, lines 39-43).

Claim 28-45,54 and 55 are rejected under 35 U.S.C. ' 102(b) as being clearly anticipated by the patents to Shimizu or Rowlett or Charhut. Each of these patents (see specific descriptions above) discloses a pill dispensing machine that comprises of a plurality of pill dispensers containing different pills, computer control means to store prescriptions, to simultaneously control each of the dispensers to count out and

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dispense the pills into a package and to stop the dispensers when the desired number of pills are dispensed. In each operation an input device allows an operator to store prescription information on the machine computer which then controls the operation of the dispensers so that simultaneous dispensing of the different pills can take place from the different dispensers according to the stored prescriptions. The machine sequentially dispenses the pills according to the prescription responsive to a predetermined command from the computer or action of the operator.

Claim 49-51 are rejected under 35 U.S.C. ' 102(b) as being clearly anticipated by the patent to Charhut.

The following is a quotation of 35 U.S.C. ' 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 17 and 19 are rejected under 35 U.S.C. ' 103(a) as being unpatentable over the patent to Charhut (5,208,762) in view of Merrill (3,139,713). The patent to Charhut does not disclose the use of a plurality of output hoppers and snouts. The patent to Merrill shows a dispensing machine which comprises of a dispensing hopper 76, a mechanical counting means 83,93, a plurality of output hoppers 86, a plurality of snouts 48 aligned in a row, and means 89 controlled by the central control system to selectively permit the release of the pills from the output hoppers, through the snouts

and into the containers to expedite the dispensing operation. It would have been obvious to one skilled in the art to provide Charhut with an in-line output/snout system as shown by Merrill to expedite the filling of the containers.

Claim 18 is rejected under 35 U.S.C. ' 103(a) as being unpatentable over the patent to Charhut (5,208,762). The use of an "on" light indicating that a specific mechanism is operating is well known in the art and it would have been obvious to one skilled in the art to provide the dispensers of Charhut with means to indicate that an individual dispenser of Charhut is operating.

Claims 16,18 and 46 are rejected under 35 U.S.C. ' 103(a) as being unpatentable over the patent to Shimizu (4,664,289) in view of Charhut (5,208,762). The patent to Shimizu discloses a pill dispensing and packaging machine that comprises of a plurality of pill dispensers containing different pills (3), computer control means (1C) to store prescriptions, to simultaneously control each of the dispensers to count out and dispense the pills into a package (12 and Figure 2) and to stop the dispensers when the desired number of pills are dispensed. The Shimizu machine lacks the use of a printer as claimed. The patent to Charhut shows a pill dispensing /counting/packaging device which comprises a pill dispenser 26 that fills containers and a labeling device 28 that labels them either during or immediately after the pills have been dispensed into the container (see column 4, lines 1-4). It would have been obvious to one skilled in the art to label the packages of Shimizu after the filling operation so that a label will not be produced for the next prescription until after pills specified in a preceding prescription have been received in the package. Regarding claim 18, the use

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of an "on", light indicating that a motor is operating is well known in the art and it would have been obvious to one skilled in the art to provide the dispenser of Shimizu with means to indicate that an individual motor 48 of the dispensers of Shimizu is operating.

Claim 17 is rejected under 35 U.S.C. ' 103(a) as being unpatentable over the patent to Shimizu (4,664,289) in view of Charhut (5,208,762), as applied above, and further in view of Merrill (3,139,713). The patents to Shimizu and Charhut do not disclose the use of a plurality of output hoppers and snouts. The patent to Merrill shows a dispensing machine which comprises of a dispensing hopper 76, a mechanical counting means 83,93, a plurality of output hoppers 86, a plurality of snouts 48 aligned in a row, and means 89 controlled by the central control system to selectively permit the release of the pills from the output hoppers, through the snouts and into the containers to expedite the dispensing operation. It would have been obvious to one skilled in the art to provide Shimizu-Charhut with an in-line output/snout system as shown by Merrill to expedite the filling of the containers.

Claims 16-18 and 46 are rejected under 35 U.S.C. ' 103(a) as being unpatentable over the admitted prior art (APA) of the IDS of 10/10/2000 in view of Charhut (5,208,762). The IDS sets forth on page 2, second paragraph, a pill dispensing and packaging machine that comprises of a plurality of adjacent pill dispensers (such as the one disclosed by Hurst in Patent No. 4,869,394) containing different pills and computer control means to store prescriptions and to simultaneously control each of the dispensers to count out and dispense the pills into an accumulating hopper controlled by a sliding door. The APA machine lacks the use of a printer as claimed. The patent to

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Charhut shows a pill dispensing /counting/packaging device which comprises a pill dispenser 26 that fills containers and a labeling device 28 that labels them either during or immediately after the pills have been dispensed into the container (see column 4, lines 1-4). It would have been obvious to one skilled in the art to label the packages of APA after the filling operation so that a label will not be produced for the next prescription until after pills specified in a preceding prescription have been received in the package. Regarding the plurality of "snouts" these read on the output tube set forth in APA. Regarding claim 18, the use of an "on" light indicating that a motor is operating is well known in the art and it would have been obvious to one skilled in the art to provide the dispensers of APA with means to indicate that an individual dispenser is operating. Since the IDS is not completely clear on the structure of the APA, applicants are requested to submit any other information available on the this device.

Claim 19 is rejected under 35 U.S.C. ' 103(a) as being unpatentable over the admitted prior art (APA) of the IDS of 10/10/2000. The IDS sets forth on page 2, second paragraph, a pill dispensing and packaging machine that comprises of a plurality of adjacent pill dispensers (such as the one disclosed by Hurst in Patent No. 4,869,394) containing different pills and computer control means to store prescriptions and to simultaneously control each of the dispensers to count out and dispense the pills into an accumulating hopper controlled by a sliding door. Regarding the plurality of "snouts" these read on the output tube set forth in APA. Regarding claim 18, the use of an "on" light indicating that a motor is operating is well known in the art and it would have been

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obvious to one skilled in the art to provide the dispensers of APA with means to indicate that an individual dispenser is operating.

Claims 22 is rejected under 35 U.S.C. ' 103(a) as being unpatentable over the patent to Rowlett. The use of bar code labels and readers to reflect the number and type of pills in a supply is well known in the art and using such a counting process when adding pills from a bulk supply to the dispensers of Rowlett would have been obvious to one skilled in the art to keep track of the number of pills being added as well as to keep track of the number of pills being removed from the bulk supply.

Claims 47 and 49-51 are rejected under 35 U.S.C. ' 103(a) as being unpatentable over the patents to Shimizu or Rowlett or Charhut. The use of a "ready" signal indicating that a specific mechanism completed its operation is well known in the art and it would have been obvious to one skilled in the art to provide the dispensers of Shimizu or Rowlett or Charhut with means to indicate that an individual dispenser is ready. Regarding claims 49-51, these patents do not disclose the filling of bottles by the dispensers but since the filling of bottles with pills is well known it would have been obvious to one skilled in the art to provide bottles under the dispensers of the machines of these references.

Claim 48 and 53 are rejected under 35 U.S.C. ' 103(a) as being unpatentable over the patent to Charhut (5,208,762) in view of Merrill (3,139,713). The patent to Charhut does not disclose the use of a plurality of output hoppers and snouts. The patent to Merrill shows a dispensing machine which comprises of a dispensing hopper 76, a mechanical counting means 83,93, a plurality of output hoppers 86, a plurality of

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snouts 48 aligned in a row, and means 89 controlled by the central control system to selectively permit the release of the pills from the output hoppers, through the snouts and into the containers to expedite the dispensing operation. It would have been obvious to one skilled in the art to provide Charhut with an in-line output/snout system as shown by Merrill to expedite the filling of the containers.

ALLOWABLE SUBJECT MATTER

Claims 1-15,20 and 23-27 are allowed.

MISCELLANEOUS PAPERS

This application is objected to under 37 CFR 1.172(a) as lacking a proper written consent of all assignees owning an undivided interest in the patent. The consent of the assignee must be in compliance with 37 CFR 1.172. See MPEP § 1410.01. A proper assent of the assignee in compliance with 37 CFR 1.172 and 3.73 is required in reply to this Office action.

This reissue application was filed without a proper offer to surrender the original patent or, if the original is lost or inaccessible, an affidavit or declaration to that effect. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

Although copies of the above forms have been filed, these are unsigned.

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Similarly, the Statement Under 37CFR3.73(b) has been submitted without a signature.

Any inquiry concerning this communication should be directed to **Examiner John Sipos** at telephone number **(703) 308-1882**. The examiner can normally be reached from 6:30 AM to 5:00 PM Tuesday through Friday.

The **FAX** number for Group 3700 of the Patent and Trademark Office is **(703) 305-3579**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. R. Rinaldi, can be reached at (703) 308-2187

Any inquiry of a general nature or relating to the status of this application should be directed to the Group Receptionist whose telephone number is (703) 308-1148.



John Sipos
Primary Examiner
Art Unit 3721

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